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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COLBERT, ELLA	
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			3624	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/863,047

Applicant(s)

ITO ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9,10,12,13,15-46 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9,10,12,13,15-46,62,63,65 and 67 is/are rejected.
- 7) ☒ Claim(s) 64 and 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3, 4, 9, 10, 12, 13, 15-46, and 62-67 are pending. Claims 1, 3, 4, 9, 10, 12, 13, 15, 16, 19, 25, 31, 62-67 have been amended in this communication filed 05/13/04 as RCE and amendment.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/13/04 has been entered.

Specification

3. The abstract of the disclosure is objected to because Figure 16 elements "3000" and "FD" are not described in the Specification. The description of elements "201" and "204" of figure 2 are missing from the Specification. Page 15, line 12 reads "601 to 607 shown in Fig. 6 correspond to the functional". Figure 6 only has elements "601 to 606" shown in the drawing figure. Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "202" has been used to designate both "CPU" and "RAM" in the description of Figure 2 in the Specification; Figure 3, element "S302" is labeled "Form feature vector v(dn) in the drawing and in the Specification element "S302" is

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referenced as “feature vector v(dn)”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 9, objected to because of the following informalities: Claim 9, line 4 reads “... in other of the”. This line would be better read “... in the other”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claims 1, 3, 4, 18-22, 35-38, 62, and 63 are rejected under 35 USC 112 6th paragraph. Applicant has an opportunity and obligation to specify in the claim limitation “means for” and to modify the phrase with functional language. In addition, the phrase “means for” must not be modified by sufficient structure, material, or acts of achieving the specified function. The Examiner is unable to find in Applicant’s Specification the corresponding structure and equivalents to “folder retaining means for retaining a new document, candidate folder identifying means for identifying at least one candidate folder and notifying means for notifying a user. What is the document retainer means,

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the new document retaining means, candidate folder identifying means, and notifying means? Where are these limitations found in the Specification? Is the retainer another folder or what is it? Applicant is respectfully requested to clarify in the Specification, the claim language, and to the Examiner these limitations and elements. See MPEP 2181.

Means plus function language in the claims and corresponding structure in the Specification is as follows:

Folder retaining means – folder or document retainer in fig. 1, element “101”;

New document retaining means – fig. 1, element “102”;

Candidate identifying means - not found in the Specification;

Notifying means – not found in the Specification;

Storing means – fig.2, elements “202” and “203”;

Judging means – fig. 3, elements “5305-5307”, page 9; and

Similarity order calculating means – fig. 3, step “5305”, page 10.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 3, 4, 9, 10, 12, 13, 15-46, and 63 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As discussed above, the following functional elements

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were not determined as being found in Applicant's Specification: "candidate identifying means and notifying means".

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 9, and 12, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, lines 7 and 8 reads "document, the at least one candidate folder having documents more similar to the new document than documents in other of the plurality of folders;". These claim limitations are vague and unclear. Does Applicant mean "document, the at least one candidate folder having documents that are more similar to the new document than documents in the other plurality of folders;"? Claims 9 and 12 have a similar problem. Lines 10 and 11 read "by said candidate folder identifying means; and ".

Does Applicant mean "identifying means " or "modifying means"?

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 9,10, 15, 23-28, 39-42, 64, and 65 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. With out a claimed basis, the claim may be interpreted in an

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alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural/functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (BD. Pat. App. & Inter. 2001) –used only for content and reasoning since not precedential]. Suggestion: Claim 9 “A computerized document processing method comprising the steps of: identifying in the computer at least one candidate folder from a plurality of”.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 15-17, 23, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,751,287) Hahn et al, hereafter Hahn.

With respect to claim 1, Hahn teaches, a folder retaining means for retaining a plurality of folders each of the folders storing at least one document (col. 1, lines 32-50, col. 2, lines 17-22 and Fig. 1c (200, 210, & 220); new document retaining means for retaining a new document (col. 2, lines 23-30); a candidate folder identifying means for identifying at least one candidate folder from a plurality of folders suitable for storing the new document, the at least one candidate folder having documents more similar to the new document than documents in other of the plurality of folders (col. 2, lines 56-64);

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notifying means for notifying a user of the at least one candidate folder by said candidate folder identifying means (col. 2, lines 65-67 and col. 3, lines 1-10); and storing means for storing the new document into a selected folder selected by the user from the plurality of folders notified by said notifying means (col. 3, lines 11-22 and col. 5, lines 9-18).

With respect to claims 3, 15-17, 23, and 28, Hahn teaches, wherein a plurality of candidate folders suitable for saving the new document are identified and a list of a plurality of identified candidate folders is displayed (col. 3, lines 11-22 and col. 5, lines 9-18).

With respect to claim 29, this dependent claim is rejected for the similar rationale given for claim 23.

Specification

12. The abstract of the disclosure is objected to because page 7, line 9 refers to element "202" in fig. 2 as "CPU" and in line 12 refers to "202" as "RAM". The drawing figure labels "202" as "RAM" and "CPU" as "201". Elements "201" and "disk 204" were not mentioned in the Specification. Figure 3, "step S302" is referred to as "feature vector V(dn) and in the drawing labeled as "FORM FEATURE VECTOR V(dn) S302". Figure 9 has a similar problem in "step S902". Figure 6, page 15, line 12 references elements "601 to 607" and the drawing figure shows elements "601 to 606". Figure 7, page 15, element "703 FOLDER SEARCH" is not found in the description of figure 7. Figure 11, elements "1102, 1106, and 1107" are referenced as "1102 document set retainer, 1106 document set score calculator, and 1107 document set score retainer."

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In the drawing figure they are labeled as "DOCUMENT-SET RETAINER 1102, DOCUMENT-SET SCORE CALCULATOR 1106, AND DOCUMENT-SET SCORE RETAINER 1107". Figure 16 is not described in the Specification (elements "3000" and "FD". The Specification and drawing labels are not in agreement. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 9, 10, 12, 13, 18-22, 24-27, 30-42, and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,751,287) Hahn et al, hereafter Hahn in view of (US 5,832,470) Morita et al, hereafter Morita.

With respect to claim 4, Hahn failed to teach, a judging means for judging a similarity degree between document information of the new document to be stored and a plurality of sets of information of the plurality of documents stored in each folder; and similarity order calculating means for calculating a similarity order of the plurality of folders in accordance with the similarity degree judged by the judging means. Morita teaches, a judging means for judging a similarity degree between document information

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of the new document to be stored and a plurality of sets of information of the plurality of documents stored in each folder (col. 13, lines 13-25); and similarity order calculating means for calculating a similarity order of the plurality of folders in accordance with the similarity degree judged by the judging means (col. 13, lines 26-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a judging means for judging a similarity degree between document information of the new document to be stored and a plurality of sets of information of the plurality of documents stored in each folder and similarity order calculating means for calculating a similarity order of the plurality of folders in accordance with the similarity degree judged by the judging means and to modify in Hahn because such a modification would allow Hahn to have a folder for storing a document judged as noise and only prepared in the folder in which a noise document exists and it can be judged that the inside of the single key word folder can be classified in detail.

This independent claim is rejected for the similar rationale given above for claim 1.

With respect to claim 9, this independent claim is rejected for the similar rationale given for claims 1 and 4.

With respect to claim 10, this independent claim is rejected for the similar rationale given for claim 4.

With respect to claim 12, Hahn teaches, a computer readable storage medium for storing programs (col. 5, lines 40-46 (floppy disks, removable hard disks, optical

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storage media such as CD-ROMS)). This independent claim is also rejected for the similar rationale given for claims 1 and 9.

With respect to claim 13, this independent claim is rejected for the similar rationale given for claims 1, 4, 9, and 10.

With respect to claim 18, 24, and 30, Hahn failed to teach, the document includes vector data. Morita teaches, the document includes vector data (col. 11, lines 20-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the document include vector data and to modify in Hahn because such a modification would allow Hahn to have the distance of the word vector and the average vector of each document calculated.

With respect to claims 19, 25, and 31, Hahn teaches, the candidate folder has a high-level rank as determined by the result of the identification (Figure 18 (1920)).

With respect to claims 20, 26, and 32, Hahn teaches, a notifying means displays a label which is set in advance to indicate the candidate folder (col. 2, lines 23-30, col. 8, lines 57-67 and Figure 18 (1900)).

With respect to claims 21, 27, 33, and 38, Hahn teaches, the document includes text data (col. 4, lines 47-49). It is inherent that electronic mail documents contain text data.

With respect to claims 22, 29, and 34, Hahn teaches, means for causing the selected candidate folder to save the new document (col. 11, lines 57-65).

With respect to claim 24, this dependent claim is rejected for the similar rationale given for claim 18.

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With respect to claim 25, this dependent claim is rejected for the similar rationale given for claim 19.

With respect to claim 26, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 27, this dependent claim is rejected for the similar rationale given for claim 21.

With respect to claim 28, this dependent claim is rejected for the similar rationale given for claim 22.

With respect to claim 30, this dependent claim is rejected for the similar rationale given for claims 18 and 24.

With respect to claim 31, this dependent claim is rejected for the similar rationale given for claims 19 and 25.

With respect to claim 32, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 33, this dependent claim is rejected for the similar rationale given for claim 21.

With respect to claim 34, this dependent claim is rejected for the similar rationale given for claim 22.

With respect to claim 35, Hahn failed to teach, wherein said notifying means provides notification only of a predetermined number of folders with a high rank of similarity order. Morita teaches, wherein said notifying means provides notification only for a predetermined number of folders with a high rank of similarity order (col. 12, lines

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42-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a notification only for a predetermined number of folders with a high rank of similarity order and to modify in Hahn because such a modification would allow Hahn to have a first hierarchy or top class of the classification system when the key word is related (high rank of similarity order).

With respect to claim 36, Hahn failed to teach, the document is stored in a folder mentioned in the notification provided by the notifying means. Morita teaches, the document is stored in a folder mentioned in the notification provided in the notifying means (col. 12, lines 65-67 and col. 13, lines 13-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the document stored in a folder mentioned in the notification provided in the notifying means and to modify in Hahn because such a modification would allow Hahn to have a single key word folder since documents attracted to one key word are stored as mentioned in a notification.

With respect to claim 37, this dependent claim is rejected for the similar rationale given for claim 26.

With respect to claim 38, this dependent claim is rejected for the similar rationale given for claim 27.

With respect to claim 39, this dependent claim is rejected for the similar rationale given for claim 35.

With respect to claim 40, Hahn failed to teach, the document is stored in at least one folder mentioned in the notification in the notifying step. Morita teaches, the

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document is stored in at least one folder mentioned in the notification in the notifying step (col. 12, lines 65-67 and col. 13, lines 13-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the document stored in a folder mentioned in the notification provided in the notifying means and to modify in Hahn because such a modification would allow Hahn to have a single key word folder since documents attracted to one key word are stored as mentioned in a notification.

With respect to claim 41, this dependent claim is rejected for the similar rationale given for claims 26 and 37.

With respect to claim 42, this dependent claim is rejected for the similar rationale given for claim 33.

With respect to claim 43, this dependent claim is rejected for the similar rationale given for claims 35 and 39.

With respect to claim 44, this dependent claim is rejected for the similar rationale given for claim 40.

With respect to claim 45, this dependent claim is rejected for the similar rationale given for claim 41.

With respect to claim 46, this dependent claim is rejected for the similar rationale given for claim 33.

With respect to claim 62, Hahn failed to teach, wherein said candidate folder identifying means identifies a plurality of candidate folders suitable for storing the new

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document as a folder to be stored, by comparing a feature of the new document with an average of features of documents stored in a folder among the plurality of folders.

Morita teaches, wherein said candidate folder identifying means identifies a plurality of candidate folders suitable for storing the new document as a folder to be stored, by comparing a feature of the new document with an average of features of documents stored in a folder among the plurality of folders (col. 2, lines 66- col. 3, line 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a system wherein said candidate folder identifying means identifies a plurality of candidate folders suitable for storing the new document as a folder to be stored, by comparing a feature of the new document with an average of features of documents stored in a folder among the plurality of folders and to modify in Hahn because such a modification would allow Hahn to compare documents in the single key word folder with each other to prepare a related key word folder or a folder stored with retrieved conditions for designating a plurality of related words to be retrieved.

With respect to claim 63, Hahn failed to teach, wherein said notifying means notifies of only the plurality of candidate folders identified by said candidate folder identifying means to a user.

Morita teaches, wherein said notifying means notifies of only the plurality of candidate folders identified by said candidate folder identifying means to a user (col. 3, lines 38-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a system wherein said notifying means notifies of only the

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plurality of candidate folders identified by said candidate folder identifying means to a user and to modify in Hahn because such a modification would allow Hahn to easily detect a desired document from a large number of documents.

With respect to claim 65, Hahn failed to teach, wherein said notifying step notifies of only the plurality of candidate folders identified in said candidate folder identifying step to a user. Morita teaches, wherein said notifying step notifies of only the plurality of candidate folders identified in said candidate folder identifying step to a user (col. 15, lines 27-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notifying step notifies of only the plurality of candidate folders identified in said candidate folder identifying step to a user and to modify in Hahn because such a modification would allow Hahn to arrange the documents according to the calculated similarities to cope with the retrieval problem.

With respect to claim 67, this dependent claim is rejected for the similar rationale as given above for claim 65.

Allowable Subject Matter

15. Claims 64 and 66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: claim 64 with a method for a plurality of candidate folders suitable for storing the new document as a folder to be stored is selected in said candidate folder selecting step by

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comparing a feature of the new document with an average of features of documents stored in a folder among the plurality of folders, was not made obvious or fairly suggested by the prior art of record.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wang et al (US 5,222,234) disclosed storing a document in a folder using a Search Result Document and saving the search results.

Bliss et al (US 5,760,770) disclosed folders, a FAT file system, and items.

Mori et al (US 5,767,847) disclosed a folder object.

Inquiries

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Colbert', with a stylized flourish extending from the end.

E. Colbert
August 18, 2004